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Attorney Docket No. 8325-2008 (G8-US1)

PATENT

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By: Yang Tang
Yang Tang

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of CHOO et al.

Serial No.: 09/996,484

Examiner: Unassigned

Confirmation No.: 2713

Art Unit: 1645

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Filed: November 28, 2001

NOV 0 6 2003

For: MOLECULAR SWITCHES

TECH CENTER 1600/2900

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT TRANSMITTAL

Enclosed is an Information Disclosure Statement and accompanying Form PTO/SB/08A for the above-identified patent application.

- ☒ In accordance with 37 C.F.R. §1.97(b), no additional fee for submission of the IDS is required.
- ☐ In accordance with 37 C.F.R. §1.97(c), also enclosed is:
- ☐ the fee of \$180.00 as set forth in 37 C.F.R. §1.17(p); or
 - ☐ a statement as specified in 37 C.F.R. §1.97(e).
- ☐ In accordance with 37 C.F.R. §1.97(d), a statement as specified in 37 C.F.R. §1.97(e) and the fee of \$180.00 as set forth in 37 C.F.R. §1.17(p) are also enclosed.
- ☐ Check No. ___ in the amount of \$___ for the total fee is attached.

☒ A return receipt postcard is also enclosed.

☐ Please charge \$_____ to Deposit Account No. 18-1648 for the total fee.
This paper is being submitted in duplicate.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 18-1648.

Dated: Oct 22/03

Respectfully submitted,

Robins & Pasternak LLP
1731 Embarcadero Road, Suite 230
Palo Alto, CA 94303
Tel: (650) 493-3400
Fax: (650) 493-3440

By:

Dahna S. Pasternak
Dahna S. Pasternak
Reg. No. 41,411

Attorney Docket No. 8325-2008 (G8-US1)

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Alexandria, VA 22313-1450

**INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. §1.97(b)**

In accordance with the duty of disclosure set forth in 37 C.F.R. §1.56,
Applicant(s) hereby submits the following information in conformance with 37 C.F.R.
§§1.97 and 1.98.

- ☒ Pursuant to 37 C.F.R. §1.98, a copy of each document cited in the attached Form PTO/SB/08 is enclosed.
- ☐ No copies of the publications listed on the attached Form PTO/SB/08A are being provided pursuant to 37 C.F.R. §1.98(d) because the publications were previously cited by or submitted to the Office in prior Application Serial No. ___ to which the above-identified application claims priority under 35 U.S.C. §120.
- ☒ Publication(s) B1-15, C1-3, C5 listed on the attached Form PTO/SB/08A were cited in a foreign search or examination report corresponding to PCT application serial no. PCT/GB00/02080 and mailed on October 10, 2000.
- ☒ Publication(s) B3, B6, B13, C1-5 listed on the attached Form PTO/SB/08A were cited in a foreign search or examination report

corresponding to PCT application serial no. PCT/GB00/02071 and mailed on October 10, 2000.

- ☐ Enclosed is a copy of a non-English publication(s) _____. Pursuant to §609 of the M.P.E.P., Applicant submits the attached foreign search or examination report, which cites such non-English language publication(s).
- ☐ Enclosed is a copy of a non-English publication(s) _____. English language publication ____ (copy enclosed) claims priority from this non-English publication.
- ☐ Enclosed is an explanation of non-English publication(s) _____ for which an English translation is not available.
- ☐ Enclosed is an English translation of non-English publication(s) _____ cited in the attached Form PTO/SB/08A.
- ☐ Enclosed is a copy of pending patent Application Serial No. _____.

This Information Disclosure Statement is filed within any one of the following time periods:

- ☐ within three months from the filing date of this national application other than a CPA under 37 C.F.R. § 1.53(d);
- ☐ within three months from the date of entry of the national stage as set forth in 37 C.F.R. §1.491 in this international application;
- ☒ before the mailing date of a first office action on the merits; or
- ☐ before the mailing of a first office action after the filing of a request for continued examination under 37 C.F.R. §1.114.

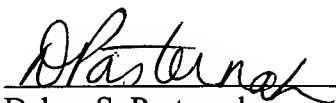
It is respectfully requested that the Examiner consider the above-noted information and return an initialed copy of the attached Form PTO/SB/08A to the undersigned.

Dated: Oct 22, 2003

Respectfully submitted,

Robins & Pasternak LLP
1731 Embarcadero Road, Suite 230
Palo Alto, CA 94303
Tel: (650) 493-3400
Fax: (650) 493-3440

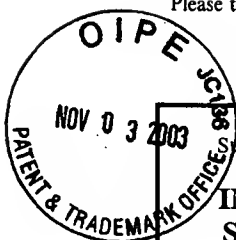
By:


Dahna S. Pasternak
Reg. No. 41,411

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PTO/SB/08A (08-00)



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|---|------|------------------------|--------------------------|-------------------|
| Substitute for form 1449A/PTO | | | Complete if Known | |
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary) | | | Application Number | 09/996,484 |
| | | | Filing Date | November 28, 2001 |
| | | | First Named Inventor | CHOO |
| | | | Group Art Unit | 1645 |
| | | | Examiner Name | Unassigned |
| Sheet 1 | of 2 | Attorney Docket Number | 8325-2008 (G8-US1) | |

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| U.S. PATENT DOCUMENTS | | | | | |
|-----------------------|--------------------------|----------------------|--------------------------------------|---|--|
| Examiner Initials* | Cite No. ¹ | U.S. Patent Document | | Name of Patentee or Applicant of Cited Document | Date of Publication of Cited Document MM-DD-YYYY |
| | | Number | Kind Code ² (if known) | | |
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| FOREIGN PATENT DOCUMENTS | | | | | | | |
|--------------------------|--------------------------|-------------------------|---------------------|--------------------------------------|---|--|----------------|
| Examiner Initials* | Cite No. ¹ | Foreign Patent Document | | | Name of Patentee or Applicant of Cited Document | Date of Publication of Cited Document MM-DD-YYYY | T ⁶ |
| | | Office ³ | Number ⁴ | Kind Code ⁵ (if known) | | | |
| | B1 | WO | 92/00388 | A1 | The Regents of the University of California | 01-09-1992 | |
| | B2 | WO | 93/23431 | A1 | Baylor College of Medicine | 11-25-1993 | |
| | B3 | WO | 94/29442 | A2 | BASF Aktiengesellschaft | 12-22-1994 | |
| | B4 | WO | 95/20652 | A1 | Altmann, Herbert | 08-03-1995 | |
| | B5 | WO | 96/01313 | A1 | Bujard, Hermann | 01-18-1996 | |
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| | B8 | WO | 96/40892 | A1 | BASF AG | 12-19-1996 | |
| | B9 | WO | 96/41865 | A1 | Ariad Gene Therapeutics, Inc. | 12-27-1996 | |
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| | B12 | WO | 98/25947 | A1 | Bristol-Myers Squibb Company | 06-18-1998 | |
| | B13 | WO | 98/53057 | A1 | Medical Research Council | 11-26-1998 | |
| | B14 | WO | 99/01549 | A1 | BASF Aktiengesellschaft | 01-14-1999 | |
| | B15 | WO | 99/10510 | A2 | Ariad Gene Therapeutics, Inc. | 03-04-1999 | |
| | B16 | WO | 00/73434 | A1 | Gendaq Limited | 12-07-2000 | |
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|--------------------|-----------------|
| Examiner Signature | Date Considered |
|--------------------|-----------------|

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number.

² See attached Kinds of U.S. Patent Documents.

³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3).

⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible.

⁶ Applicant is to place a check mark here if English language Translation is attached.



PTO/SB/08A (08-00)

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|--|--------------------|---|---|-----------------------------|-------------------|
| Substitute for form I 449B/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary) | | | | Complete if Known | |
| | | | | Application Number | 09/996,484 |
| | | | | Filing Date | November 28, 2001 |
| | | | | First Named Inventor | CHOO |
| | | | | Group Art Unit | 1645 |
| Examiner Name | Unassigned | NOV 0 6 2003 TECH CENTER 1600/2900 | | | |
| Attorney Docket Number | 8325-2008 (G8-US1) | | | | |
| Sheet | 2 | of | 2 | | |

| OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS | | | |
|---|-----------------------|---|----------------|
| Examiner Initials* | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T ² |
| | C1 | Dickinson et al., "Inhibition of RNA Polymerase II Transcription in Human Cells by Synthetic DNA-Binding Ligands," <i>PNAS</i> 95(22):12890-12895 (1998) | |
| | C2 | Dickinson et al., "Inhibition of Ets-1 DNA Binding and Ternary complex Formation Between Ets-1, NF-KappaB, and DNA by a Designed DNA-Binding Ligand," <i>Journal of Biological Chemistry</i> 274(18):12765-12773 (1999) | |
| | C3 | Gatz et al., "Stringent Repression and Homogenous De-Repression by Tetracycline of a Modified CaMV 35S Promoter in Intact Transgenic Tobacco Plants," <i>Plant Journal</i> 2(3):397-404 (1992) | |
| | C4 | Gottesfed et al., "Regulation of Gene Expression by Small Molecules," <i>Nature</i> 387(6629):202-205 (1997) | |
| | C5 | Weinmann et al., "Chimeric Transactivator Allows Tetracycline-Responsive Gene Expression in Whole Plants," <i>Plant Journal</i> 5(4):559-569 (1994) | |
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| Examiner Signature | | Date Considered | |
|---------------------------|--|------------------------|--|

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¹ Unique citation designation number.

² Applicant is to place a check mark here if English language Translation attached.